



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,404	09/17/2001	Jiang Peng	42390P11100	1200

8791 7590 03/02/2006

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

EXAMINER

SHAPIRO, LEONID

ART UNIT	PAPER NUMBER
----------	--------------

2677

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/955,404

Applicant(s)

PENG, JIANG

Examiner

Leonid Shapiro

Art Unit

2677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-14 and 16-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-14, 16-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Objections

1. Claim 19 objected to because of the following informalities: At the end of the claim 19 after dot there is the number 5.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4, 7-13, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagaoka (US Patent No. 6,791,773 B2) in view Hoggarth (Pub. No.: US 2002/0057257 A1).

As to claim 1, Nagaoka teaches a portable communication device (See Col. 1, Lines 8-12) comprising:

a display (See Fig. 1, item 6, Col. 5, Lines 60-67);

and a detachable joystick (in the reference is equivalent to detachable operating stick (See Fig. 1, item 8); wherein the portable communication device is adapted to receive the detachable joystick (See Fig. 1, item 8, Col. 8, Lines 29-34), and the detachable joystick provides a user input indicated with a display (See Fig. 4, item 8, Col. 7, Lines 1-15), wherein the detachable joystick is capable of being stored within the portable communication device when not in use (See Fig.1, items 1, 8).

Notice, that when the portable communication device (See Fig.1, item 1) not in use (turned off), the detachable joystick (See Fig.1, item 8) still remained within the portable communication device (See Fig.1, item 1).

Nagaoka does not show the detachable joystick comprises a user depressible button.

Hoggarth teaches the detachable joystick comprises a user depressible button (See Fig. 4, item 80, in description See Page 3, paragraph 0033).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Hoggarth approach in Nagaoka apparatus in order to devise a seamless mechanically and electrically integrated joystick (See Page1, paragraph 0013 in Hoggarth reference).

As to claim 12, Nagaoka teaches a method comprising:

providing user input to a portable communication device using detachable joystick (See Fig. 4, item 8, Col. 7, Lines 1-15), wherein the detachable joystick is capable of being stored within the portable communication device when not in use (See Fig.1, items 1, 8).

Notice, that when the portable communication device (See Fig.1, item 1) not in use (turned off), the detachable joystick (See Fig.1, item 8) still remained within the portable communication device (See Fig.1, item 1).

Nagaoka does not show the detachable joystick comprises a user depressible button.

Hoggarth teaches the detachable joystick comprises a user depressible button (See Fig. 4, item 80, in description See Page 3, paragraph 0033).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Hoggarth approach in Nagaoka apparatus in order to devise a seamless mechanically and electrically integrated joystick (See Page1, paragraph 0013 in Hoggarth reference).

As to claims 4, 13, Nagaoka teaches the detachable joystick 9operatinal stick in the reference) is adapted to indicate desired movement of a cursor on the display (in the reference operational stick is used instead of a set of push buttons) (See Fig. 4, items 2, 7-8 Page 2, Col. 7, Lines 1-15).

As to claim 11 Nagaoka teaches the portable communication device is a cellular phone (See Fig. 1, Col. 1, Lines 5-12).

As to claims 7-8, Hoggarth teaches the detachable joystick trigger closes the electrical circuit causing a signal to be relayed to the COM1 port (See Fig. 4, items 90,120,122, in description See Page 3, paragraph 0032).

As to claim 9, Nagaoka does not show detachable joystick comprises ink.

Since critically of usage of ink was not shown in specification or drawings, it would have been obvious to one of ordinary skill in the art at the time of the invention to assume that pen tip in Nagaoka and Hoggarth apparatus will contain ink. Therefore, the presence or absence of ink in the pen tip fails to patentably distinguish over the Nagaoka and Hoggarth references.

As to claim 10, Nagaoka and Hoggarth do not show the detachable joystick is adapted to indicate movement across the display on pixel-by-pixel basis.

Since critically of pixel-by-pixel not shown in specification or drawings, it would have been obvious to one of ordinary skill in the art at the time of the invention to assume that movement in Nagaoka and Hoggarth apparatus will be done on pixel-by-pixel basis or on group of pixels-by-group of pixels. Therefore, pixel-by-pixel movement fails to patentably distinguish over the Nagaoka and Hoggarth references.

As to claim 18, Hoggarth teaches the detachable joystick trigger closes the electrical circuit causing a signal to be relayed to the COM1 port (See Fig. 4, items 90,120,122, in description See Page 3, paragraph 0032).

3. Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caravella et al. (US Patent No. 6,041,221) in view of Nagaoka and Hoggarth.

As to claim 21, Caravella et al. teaches an apparatus comprising:

a processor (See Fig. 1, item 18, in description See Col. 1, Lines 9-19 and Col. 2, Lines 10-17);

a static random access memory coupled to the processor (See Fig. 1, item 24, in description See Col. 1, Lines 9-19 and Col. 2, Lines 10-17);

communication module to transmit a wireless communications (See Fig. 1, items 12,14,16, in description See Col. 1, Lines 9-19 and Col. 2, Lines 10-17).

Caravella et al. do not show a display and detachable joystick to provide a user input indicated with the display, wherein the detachable joystick is capable of being stored within the portable communication device when not in use.

Nagaoka teaches display (See Fig. 1, item 6, Col. 5, Lines 60-67); and a detachable joystick to provide a user input indicated with a display (See Fig. 4, item 8, Col. 7, Lines 1-15), wherein the detachable joystick is capable of being stored within the portable communication device when not in use (See Fig.1, items 1, 8).

Notice, that when the portable communication device (See Fig.1, item 1) not in use (turned off), the detachable joystick (See Fig.1, item 8) still remained within the portable communication device (See Fig.1, item 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Nagaoka display and detachable joystick in Caravella et al. apparatus in order to make an image system so compact that it can be mounted on a portable telephone (See Col. 1, Lines 39-43 in Nagaoka reference).

Nagaoka and Caravella et al. do not disclose the detachable joystick comprises a user depressible button.

Hoggarth teaches the detachable joystick comprises a user depressible button (See Fig. 4, item 80, in description See Page 3, paragraph 0033).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Hoggarth approach in Nagaoka and Caravella et al. apparatus in order to devise a seamless mechanically and electrically integrated joystick (See Page1, paragraph 0013 in Hoggarth reference).

As to claim 23, Nagaoka teaches the detachable joystick is capable of being stored within the portable communication device when not in use (See Fig.1, items 1, 8).

As to claim 22, Hoggarth teaches the detachable joystick comprises a user depressible button (See Fig. 4, item 80, in description See Page 3, paragraph 0033).

As to claim 24, Hoggarth teaches the detachable joystick trigger closes the electrical circuit causing a signal to be relayed to the COM1 port (See Fig. 4, items 90,120,122, in description See Page 3, paragraph 0032).

4. Claims 5,14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagaoka and Hoggarth as aforementioned in claims 1, 13 in view Chan et al. (US Patent No. 6,346,938).

Nagaoka and Hoggarth do not show the detachable joystick is adapted to select an icon on the display.

Chan et al. teaches pushing forward on the joystick moves user icon location (See Fig. 8, items 805-806, in description See Col. 11, Lines 4-7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Chan et al. approach in Nagaoka and Hoggarth apparatus in order to navigate through application software.

5. Claim 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caravella et al., Nagaoka and Hoggarth as aforementioned in claims 21.

Caravella et al., Nagaoka do not show detachable joystick comprises ink.

Since critically of usage of ink was not shown in specification or drawings, it would have been obvious that Caravella et al., Nagaoka and Hoggarth apparatus will contain ink. Therefore, the presence or absence of ink in the pen tip fails to patentably distinguish over the Caravella et al., Nagaoka and Hoggarth references.

6. Claims 6, 16-17, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagaoka and Hoggarth as aforementioned in claim 1 in view of Lehtinen et al. (US Patent No. 6,518,957 B1).

As to claim 6, Nagaoka and Hoggarth do not disclose motion sensors (in the reference is equivalent to touch screen) sense movement of the detachable joystick.

Lehtinen et al. teaches motion sensors (in the reference is equivalent to touch screen) sense movement of the detachable joystick (See Fig 2, items 6, 16, Col. 2, Lines 27-31).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Lehtinen et al. approach in Nagaoka and Hoggarth apparatus in order to disable the touch sensitive screen when data input apparatus in the device (See Col. 1, Lines 55-57 in the Lehtinen et al. reference).

As to claims 16,19, Nagaoka and Hoggarth do not disclose inserting and removing the detachable joystick into the portable communication device.

Lehtinen et al. teaches inserting and removing the detachable joystick into the portable communication device (See Figs. 2, 4, item 16, Col. 4, lines 2-22).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Lehtinen et al. approach in Nagaoka and Hoggarth apparatus in order to disable the touch sensitive screen when data input apparatus in the device (See Col. 1, Lines 55-57 in the Lehtinen et al. reference).

As to claims 17, 20, Hoggarth teaches the detachable joystick trigger closes the electrical circuit causing a signal to be relayed to the COM1 port (See Fig. 4, items 90,120,122, in description See Page 3, paragraph 0032).

Response to Arguments

7. Applicant's arguments filed on 01/04/06 have been fully considered but they are not persuasive:

On page 11, 2nd paragraph of Remarks, Applicant's stated that the size and shape of the joystick with the depressible button and the impossibility of being stored even within a large laptop computer -much less the device of the present invention. Applicant submits that combining as the art is dissimilar and the references would be problematic and improper joysticks are of a completely different shape. If one examines the joystick of Nagaoka, it would be difficult to see where you could place a depressible button (especially if it were to be storable in the body). However, "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

See also *In re Sneed*, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983) (“[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review.”); and *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973) (“Combining the teachings of references does not involve an ability to combine their specific structures.”).

On page 11, 3rd paragraph of Remarks, Applicant's stated that Hoggarth provides a control post electromechanically engaged... However, Nagaoka teaches also control post electromechanically engaged.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Telephone inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leonid Shapiro whose telephone number is 571-272-7683. The examiner can normally be reached on 8 a.m. to 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amr Awad can be reached on 571-272-7764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LS
03.15.06



BIPIN SHALWALA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600